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OFFICE OF PETITIONS

In re Application of
Sundstrom, et al. :
Application No. 09/904,837 :
Filing Date: 16 July, 2001 :
Attorney Docket No. 150-001 :

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 16 July, 2001.

The Office regrets the delay in addressing this matter. It is noted that messages were left for Petitioner by an attorney from the Office of Petitions to Petitioner on 18 and 19 November, 2004 (to request a document referenced in the petition but absent from the filing), however, as of this writing there has been no reply from Petitioner.

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- the application was filed on 17 July, 2001, without, *inter alia*, a fully executed oath or declaration; and
- the instant petition was filed contemporaneously with the application;
- the petition references, *inter alia*, an oath/declaration signed by named inventors save for Olaf Johansson (Mr. Johansson); and a declaration by Petitioner Steven S. Payne (Reg. No. 35,316), and a copy of a letter from Petitioner to the non-signing inventor Mr. Johansson, however the copy of the letter to Mr. Johansson was not included with the filing.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to

in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted. (And a reasonable effort must be made to ascertain a current or last known address.)

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹

CONCLUSION

Due to the absence of the referenced letter from Petitioner to Mr. Johansson transmitting materials, there is a question whether the submission clearly evidences that the entire application was sent to the alleged non-signing inventor. Petitioner should submit a copy of the transmittal letter (in English or in English translation declared by Petitioner to be accurate).

In addition, Petitioner must either provide that last known/current address or evidence that a reasonable and responsible effort has been made to ascertain that address to no avail.

Therefore, the instant petition must be and hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents²
 P.O. Box 1450
 Alexandria, VA 22313-1450

¹ See: MPEP 409.03(b).

² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By FAX: (703) 872-9306 (IFW Formal Filings)
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
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Lobby/Room 1B03
Crystal Plaza Two
220 20th Street S.
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Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



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Office of Petitions